REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-8 are now in the application. Claims 1-5 remain unchanged. Claims 6-8 have been added.

More specifically, claims 6 has been added to further emphasize the activity by the customer, namely, the fact that the customer actually downloads and actually executes the simulation program. Claim 7 has the customer "disconnected" from the download server. These additional method claims are being added in response to the Examiner's statements concerning the "enabling" language in the claims. As becomes clear from logical reasoning, and from the following line of argumentation, claim 1 is patentable if claims 6 and 7 are patentable.

Similarly, claim 8 has been added to further emphasize the nature of the simulation program and to add the negative limitation concerning the disconnection from the server. It is noted that the "disconnection" was already included (directly or inherently) in the term "standalone."

We now turn to the Office action in detail. First, it is appreciatively noted that all of the issues leading to the

appeal and all of the prior grounds of the final rejections have been overcome. In this regard, the Examiner is requested to revise his obviously incorrect statement that our arguments in the Brief on Appeal "have been carefully considered, but are not persuasive." Office action, page 10. All of the arguments have apparently been successful in that prosecution has been reopened and none of the final rejections have been maintained.

Claim Rejections - 35 U.S.C. § 112

On page 2 of the detailed action, the Examiner rejected the claims under 35 U.S.C. § 112, first paragraph, as not being enabled by the specification. According to the Examiner, the specification lacks enabling detail and the specification "appears to merely disclose generalities." We respectfully disagree. While it is true that the specification describes much of the subject matter on a conceptual level, there is provided sufficient detail to enable one of skill in the pertinent art to make and use the invention.

The § 112 rejection had been presented by the Examiner in a first Office action on November 30, 2004. Upon receiving applicants' response, the Examiner withdrew the rejection but stated that the withdrawal was "for reasons other than as provided by Applicants." Office action 9/26/2005, page 4.

Instead, the withdrawal was necessary because "a review of the applied prior art indicates that the claimed subject matter is such that those of ordinary skill in the art would be able to make and use the claimed invention." Id. We fully agree. The renewed rejection is quite suggestive of piece-meal prosecution and we shall not further this issue beyond what we have stated before (i.e., the prior response to this rejection is herewith incorporated by reference).

Those of ordinary skill in the art know simulators. They know how to make a simulator and they know how to program a simulator. As described in the specification, computerized simulators for integrated circuits or other electronic circuits are well known in the art. The person of skill in the art also knows what an online catalogue is, what a vendor catalogue is, and how they can be assembled and processed. A certain amount of assembly work will, of course, be required and it may even take a certain amount of experimentation before the standalone simulator that is tagged to the specific electronic component may be ready for distribution. The dispositive issue, however, is that making and/or using the invention will not require "undue" experimentation.

The Examiner is requested to once more reconsider the rejection under 35 U.S.C. § 112, first paragraph. The claimed

invention is indeed described with sufficient detail so as to enable one of skill in the art to make and/or use the invention without undue experimentation.

Claim Rejections - 35 U.S.C. § 102

We first turn to the art rejection in which claims 1-5 have been rejected as being anticipated by Fin et al. (hereinafter "Fin") under 35 U.S.C. § 102(b). We respectfully traverse.

As a preliminary housekeeping matter, applicants have not been able to ascertain the exact publication date of Fin and it is not entirely clear that § 102(b) is indeed applicable. The Examiner's cooperation in this matter is requested.

Fin does not anticipate the claimed invention. Fin is instead concerned with providing a simulator "without disclosing IP information." Fin, p.597, left column. Fin further summarizes:

> This paper proposes to concentrate the source of simulations directly in the Web server of the core vendor, by proposing a typical client-server architecture, where the core users perform distributed simulations by connecting their simulation environment to the simulation environment of the core vendor.

Fin, p. 597, right column. The paper further describes a typical application of their novel features, namely, a system wherein the core user downloads the simulation suite for execution on their computer. The simulation suite, however, is

not functional without the specific data input which the user obtains through the vendor's server. It lies indeed at the heart of Fin's paper that the user must access the vendor's server for the simulation. Otherwise, the downloaded simulation suite would not make any sense, because it would lack the necessary data ("the IP information").

Fin provides concluding remarks which once again summarize the essence of the paper:

> A Web-CAD methodology for IP-Core analysis and simulation has been proposed in the paper. It allows the core vendor to make available very detailed core models without disclosing IP information. This is possible since the proposed client/server architecture allows the core user to integrate in the project a design entity, representing the core, which interfaces the client simulator to the server simulator.

Fin, p. 600, right column.

It is quite clear from the foregoing that Fin's user must be connected to the vendor's server in order to execute the simulation. The user, therefore, does not execute a "standalone" simulator, nor does the vendor's system provide for a "computer-executable file" which allows standalone functionality.

The issue, then, appears to hinge on the Examiner's statement concerning his interpretation of the "enabling" language in

the claims ("no patentable weight is provided for 'enabling' because the recitations are not required for the claim," Office action, p.5). Respectfully, we are simply at a loss. The "standalone" feature is essential to the claimed invention. Applicants' have described and recited the functionality from a viewpoint of the vendor (i.e., the method is performed by the vendor, and the product support system is the vendor's) and, accordingly, the claim language "enables" the user to perform certain steps and/or provides software that enables the user to perform certain routines.

The "enabling" language in the claims must indeed be afforded patentable weight. The steps of "enabling download" and "enabling the customer to execute a simulation" are indeed required by the claims. Also, the system necessarily enables a download so that the "standalone simulators" may be executed by the user.

Claims 1-5, if properly interpreted, are not anticipated by Fin. Reconsideration of the rejection is requested.

Next, we turn to the rejection of claims 1-5 as being anticipated by McDonald et al. (US 6,530,065 B1 "McDonald") under 35 U.S.C. § 102(e). We respectfully traverse.

As noted above, the instantly claimed invention deals with standalone simulators and with their adaptation to a specific electronic component. Claim 1 of the instant application calls for a method in which a computer-executable file with a standalone simulator is stored and offered for download and in which the customer is enabled to execute a simulation in standalone mode. Claim 4 deals with a product support system in which standalone simulators are stored, offered for download, and enabled for execution in standalone mode as a standalone simulator.

The invention recited in claims 1 and 4 is not anticipated by McDonald. The reference deals with on-line simulators and catalogs. Specifically, McDonald represents the *Transim* system as it was described in the introductory text of the specification. McDonald describes an on-line system where the user is required to remain connected (or reconnect several times during the process as is typical in such executable applets) to the web server. In the preferred embodiment, of course, the web server is available through the World Wide Web.

In McDonald, the client-side applet is run on the client computer 150 and the primary simulation is performed at the server side. This is further underscored by stating that

"[t]he applet creates a tcp/ip socket to the server 100 for messaging and communication." Col. 8, lines 47-48. The TCP/IP socket, of course, is required in order to continue the on-line session.

The Examiner points with specificity to McDonald's disclosure in col. 11, lines 20-37, and "especially lines 34-37." Lines 20-34 indeed describe the details of storing various "links" and "Web pages," etc.. Lines 34-37 then explain:

> While aspects of the invention are described herein using a networked environment, some or all features may be implemented within a single-computer environment.

McDonald, col. 11, lines 34-37.

As best understood, this disclosure pertains to the details of a distributed network system in which a central server branches to various other computers for display descriptions and format information. The quoted text then appears to point to a single server computer, as opposed to a distributed network with link-accessible distributed sites. In other words, McDonald's simulator is executed on the server and the user is defined as a client. The above-quoted text is clearly not specific enough to "teach" or even suggest applicants' standalone functionality.

Claims 1 and 4 are not anticipated by McDonald. The Examiner is respectfully urged to withdraw the rejection over McDonald.

Claim Rejection - 35 U.S.C. § 103

This rejection is not clearly stated. We presume that the Examiner meant to state in item 18 on page 7 that claims 1-5 are "unpatentable over Beall in view of McDonald and in view of Squier." If this is not correct, counsel would request the Examiner to telephone counsel so that the matter may be resolved.

Beall deals with on-line simulators and catalogs. Beall allows an applet to be downloaded and executed within the user's web browser. The necessary data for display and processing in the applet are provided by the on-line server. As a matter of fact, Beall describes a system where a part may have "additional information associated with it on the World Wide Web." Col. 15, lines 57-58. When the user clicks on a specific link, an HTML document may be accessed or an applet may be downloaded with executable content. Beall provides an example, namely, "a circuit simulation applet to model the selected integrated circuit's performance." Col. 15, line 66, to col. 16, line 1. Beall goes on to explain that the user may browse

the necessary information and choose from additional information.

> Any of these associated URLs might also be Java applets, whose launch results in execution of the applet locally within the user's web browser 4014. For example, an output voltage attribute might have an associated HTML page containing an applet that interacts with the user, accepting various input parameters and dynamically graphing the resulting voltage or current curves representing device characteristics. This allows for interactive functionality associated with any database element to be delivered to the user on demand.

Beall, col. 16, lines 12-21.

It is entirely clear that Beall's user remains connected to the server at all times during the execution of the applet. The applet within the web browser requires additional input that is retrieved in an interactive sense from the server. In this regard, Beall's example is not different from McDonald (and the *Transim* system described in the last paragraph of page 3 of the specification).

McDonald cannot cure the problem associated with the primary reference. The secondary reference, as discussed above, also has the user connected and he does not provide for standalone execution.

Squier is appreciatively acknowledged. The reference provides information concerning applets and standalone applications. In fact, Squier is a very suitable reference with regard to the

§ 112 issues. The teaching provides information with regard to the conversion of an applet to a standalone program. The teaching further emphasizes the differences between an "applet" and a "standalone" application. The paper should further inform the disclosure.

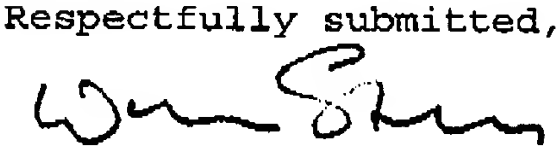
What Squier does not provide, however, is anything that could be used to modify the primary references Beall and McDonald. In fact, both Beall and McDonald require the "connection" and they do not in the least suggest or contemplate a standalone simulator. The modification of these teachings with Squier would run contrary to their very teachings. Further, neither references nor the art as a whole contain any suggestion towards the combination. A proper § 103 rejection, however, requires the showing of a "clear and particular" suggestion and/or motivation to combine the references. This, the Examiner has failed to do. The rejection, therefore, is in error.

None of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 and 4. These claims are, therefore, patentable over the art and since all of the dependent claims are ultimately dependent thereon, they are to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-8 are solicited.

Petition for extension is herewith made. Counsel's payment in the amount of $120.00 for a one-month extension is enclosed herewith. Please charge any other fees which might be due during the pendency of this application to Deposit Account No. 12-1099 of Lerner Greenberg Stemer LLP.

Respectfully submitted,



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